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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,461	12/12/2003	Bonnie M. Pemberton	31960.0104	9697
7590 Schlutz & Associates, P.C. 5400 LBJ Freeway Dallas, TX 75240		12/27/2007	EXAMINER OSELE, MARK A	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 12/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/734,461	PEMBERTON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mark A. Osele	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7-15 is/are pending in the application.
- 4a) Of the above claim(s) 7-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Straub (U.S. Patent 4,824,702) in view of Ferraro (U.S. Patent 4,511,608), Kriozere (U.S. Patent 4,348,440), and Ittershagen et al. (U.S. Patent 5,168,831). Straub shows a plurality of continuous, unperforated double sided adhesive elements, 13, releasably adhered to and arranged side-by-side on a planar, unperforated transfer sheet, 16, and a plurality of continuous unperforated release layers, 15, each of the release layers releasably adhered on the second adhesive surface of the strips (Fig. 1), wherein the strips are adapted to be removed from the transfer sheet and releasably adhered to an article on the first adhesive surface and the release layers are adapted to be removed from the second adhesive surface revealing the second adhesive surface. The adhesive of Straub is shown to be sufficient to hold an artificial fingernail to a finger and this tack strength would be sufficient to cause a sticking sensation. Straub fails to show the release layers bisected and the same length as each of the strips.

Ferraro also shows a plurality of continuous, unperforated double sided adhesive elements, 5, releasably adhered to and arranged side-by-side on a planar, transfer sheet, 21, and a plurality of continuous unperforated release layers, 9, each of the release layers releasably adhered on the second adhesive surface of the strips and bisected at 19. Ferraro shows that release layers substantially the same length as each of the strips and including a bisecting line, 19, is an alternative means for applying a double sided adhesive tape to a substrate. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the equivalent length, bisected release layers of Ferraro in the article of Straub because they are shown to be functionally equivalent alternate expedients.

Kriozere shows that the backing sheet, 16, 18, of a rectangular adhesive element, 12, is slit along the central longitudinal axis, 20, to aid in alignment of the strip (column 1, line 65 to column 2, line 6). A similar slit along the center perpendicular to the longitudinal axis would not be as desirable because a user typically requires alignment of the long side of a rectangular article, such as when applying masking tape. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a central slit in the release sheets of the rectangular, double-sided adhesive elements of the references as combined above because Kriozere shows that a slit along the central longitudinal axis allows for alignment of a rectangular article.

Ittershagen et al. teaches that one use for double sided adhesive tapes is to prevent an animal from touching an undesired region. This is accomplished by making the adhesive layers transparent (column 3, lines 1-6, 10-13, 62-68) and making the top

adhesive of a tack strength sufficient to cause a releasable sticking sensation to the animal (column 1, lines 17-20; column 3, lines 21-30) and the bottom adhesive layer capable of being releasably adhered to home furnishings (column 2, lines 14-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the double-sided adhesive element of the references as combined above transparent and with tack strength to releasably adhere to an animal because Ittershagen et al. teaches the benefits of these adhesive materials in preventing an animal from touching undesired regions.

Regarding claims 2 and 3, Straub shows the strips are uniformly spaced apart from one another by gaps on the transfer sheet that are parallel to the length of the strips and are of a width that is equal to a substantial fraction of the width of the strips to provide an indication of an edge of the plurality of the strips.

### ***Response to Arguments***

3. Applicant's arguments filed November 29, 2007 have been fully considered but they are not persuasive.

Applicant first argues (section I) that it is unclear whether Kriozere is incorporated to modify Ferraro or Straub or both. Applicant has ignored the phrase "as combined above" when referring to the "double sided adhesive element of the references." It is clear from the rejection that Kriozere modifies the references as combined above (Straub in view of Ferraro) and Ittershagen modifies the reference as combined above (Straub in view of Ferraro and further in view of Kriozere).

Applicant also argues that Straub and Ferraro fail to show a bisecting cut.

Although applicant is accurate that Ferraro does not show a bisecting cut, Ferraro does show a bisecting embossed line to aid in separating the release sheet from the adhesive strip and Kriozere shows the use of a bisecting cut. Although Straub and Ferraro do not specifically show the bisecting line to be a cut, the combination of Straub, Ferraro, and Kriozere do show the bisecting cut.

Applicant next argues that one of ordinary skill would not add the bisecting line of Ferraro into the adhesive strips of Straub because the bisecting line of Ferraro performs the same function as the overlapping cover sheet of Straub: removal of the release sheet from the adhesive strip. This is not an accurate description of the Straub reference. As applicant has pointed out, the extending lip of Straub is included so that in the manufacturing process, the die cut does not come in contact with the adhesive material. Whether the extending lip of Straub could also be used to remove the release sheet is conjecture because it is not disclosed by Straub. The bisecting line of Ferraro is clearly disclosed as intended for release sheet separation, therefore, one of ordinary skill in the art would add the bisecting line of Ferraro to the adhesive strips of Straub because Ferraro teaches that the bisecting line can aid in removal of the release sheet.

Applicant further argues that Kriozere would not be combinable with either Straub or Ferraro. As explained above, Kriozere is not included to modify either Straub or Ferraro, but rather to modify the article of Straub in view of Ferraro. The following responses do not directly correlate with applicant's arguments because the examiner has attempted to place those arguments in the context of Kriozere used to modify the

article of Straub in view of Ferraro. Applicant contends that there is no advantage to replace the embossed bisecting line of the references as combined with the axial bisecting cut of Kriozere because the embossed bisecting line already aids in removing the release sheet and the alignment of the article is based upon the shape of a user's fingernail. By adding the bisecting cut of Kriozere into the article of the references as combined, a user can remove a first cover sheet, thereby exposing half of the adhesive, and place the exposed adhesive on either the real or artificial fingernail while grasping the portion still protected by the remaining cover sheet. In this way, the user can superimpose the adhesive strip above the fingernail, ensure that it is in the proper position without extending beyond its target, and thereafter pressing the exposed portion of the adhesive into place. Now that the adhesive is properly placed and adhered, the user can remove the remaining cover sheet and press the remainder of the adhesive strip into contact. Contrary to applicant's assertion, this alignment is beneficial because improperly locating the adhesive strip could overlap a user's skin, which would become irritated from the adhesive, and/or extend beyond the edge of the artificial fingernail, which would be unsightly.

Applicant further argues that Ittershagen would not be combinable with either Straub or Ferraro or Kriozere. As explained above, Ittershagen is not included to modify either Straub or Ferraro or Kriozere, but rather to modify the article of Straub in view of Ferraro and further in view of Kriozere. The following responses do not directly correlate with applicant's arguments because the examiner has attempted to place those arguments in the context of Ittershagen used to modify the article of Straub in

view of Ferraro and further in view of Kriozere. Applicant argues that there would be no reason to make the adhesive of the references as combined transparent because it is covered by an artificial fingernail. Many artificial fingernails are transparent themselves and it would be important to have a transparent adhesive holding them in place so that the adhesive does not show through. Regarding applicant's argument that the releasable adhesive of Ittershagen would not function to effectively hold an artificial fingernail in position, many artificial fingernails are only meant to be worn for a short amount of time, such as for a social event or for the length of a performance when worn as part of a costume. In these circumstances, releasable adhesive would be most effective at holding the fingernail for the desired length of time, yet allow for easy removal afterward.

Applicant's arguments regarding the 35 U.S.C. §112, second paragraph was persuasive and that rejection has been rescinded.

Regarding the arguments regarding secondary considerations of non-obviousness, the examiner refers back to the response to arguments of the office action of September 25, 2006. Applicant's additional arguments in the paper of November 29, 2007, have not overcome the examiner's perspective that the secondary considerations are not persuasive. Applicant's have included a supplemental declaration of Ms. Bonnie Pemberton. In this supplemental declaration, the declarant refers to the question raised by the examiner in the paper of November 29, 2007 of whether the quoted market share of her product includes the double sided adhesive tape sold by 3-M, but does not answer this question. Without this information, the examiner cannot make a fully



comprehensive assessment of the strength of the market share argument.

Furthermore, the supplemental declaration states that applicant's product is not a repackaging of the 3-M tape because the 3-M tape is not flat and does not have a bisected cover sheet. It is the examiner's position that providing the tape on a flat wheel with a bisected cover sheet are packaging changes, not changes to the product sold by 3-M, namely a double sided adhesive tape.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

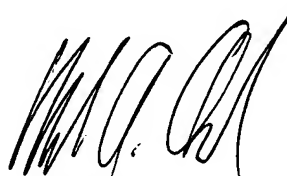
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MARK A. OSELE  
PRIMARY EXAMINER

December 22, 2007